

The Office Action admits that “Perfection does not teach a USB host controller.” The Office Action then quotes from the Zone publication concerning the alleged capability of two USB embedded host controllers, the CY7C67300 and the CY7C67200 manufactured by Cypress Semiconductor (“Cypress”). It is emphasized that the CY7C67300 controller is expressly disclosed in the present application as providing the best mode for practicing the present invention.

Specifically, the Zone article lists a number of items – none of which is a scanner – that could be connected to each other “without the need for a host computer.” The Office Action then asserts that it would have been obvious “to use the Cypress CY7C67300 to connect a stand alone scanner to a stand alone printer.” According to the Office Action this use would have been obvious because a scanner takes pictures of paper, scanners are often connected to a printer via a USB port and printers and cameras are included in the list of peripheral devices in the Zone publication.

B. Reply Re Claims 1-3, 7 and 9-10

In reply to the specific grounds asserted in the rejection of claims 1-3, 8 and 9-10, Applicant would point out that the Office Action has failed to establish *prima facie* obviousness. In order to establish *prima facie* obviousness, a suggestion, motivation or teaching to make the claimed combination must be found in the cited prior art. Here there is none.

As admitted in the Office Action the 1999 Perfection publication has no teaching of a USB host controller, and the 2003 article has no teaching about any type of scanner, much less

any of the types of flatbed scanners described as embodiments of the present invention. As such it immediately is apparent that the rejection is based on a hindsight analysis, and therefore should be withdrawn.

Furthermore, and in contrast to the assertions in the Office Action, the Perfection and Zone publications actually teach away from the claimed invention. While the Zone publication lists numerous devices for which the Cypress controller could be used, none is a scanner. Thus, the absence in the listing of any scanner, but the presence in that same listing of numerous other devices apparently alleged to be adapted for use with the Cypress USB controller suggests that the claimed combination was not reasonably implied by the author of the article and was not reasonably inferable from the article by a person of ordinary skill in the art.

Additionally, the Zone publication does not disclose any such adaptation for an external controller, for such a controller adapted for use with a scanner, for a port adapted to communicate with a scanner port, a second port adapted to communicate with another peripheral device, all of which are required by claims 7-10 of the present application.

C. Reply Re Claims4-6

Claims 4-6 were additionally rejected, apparently on the grounds that each included as a claim element a device that was listed in the Zone publication (claim 4 memory card reader; claim 5 network interface and claim 6 media storage device). However, none of the three devices of claims 4-6 were expressly identified in the Zone publication. The Zone publication lists only “cell phones, PDAs, printers cameras and music players” (1st paragraph of text); “set-top boxes,

DVD players, Internet appliances, wireless access points, print servers and KVM switches” (2nd paragraph of text); “cell phones, PDAs, video and still cameras, MP3 players and mass storage devices” (3rd paragraph of text); “automotive electronics” (13th paragraph of text).

Assuming arguendo that the devices of dependent claims 4-6 were listed, or reasonably taught in the Zone publication, there is no teaching of a scanner in the Zone publication.

Even more importantly, there is no teaching of connecting any of the devices in claims 4-6 to a scanner as set forth in independent claim 1.

In essence, the Office Action speculates that it would have been obvious to connect the specifically recited peripheral devices to a stand alone scanner having the claimed host controller when the prior art fails to disclose any of the scanner or the peripherals. As such the conclusion reached in the Office Action is pure speculation and is a result of using Applicant’s own invention as prior art.

C. Reply Re Claim 8

Dependent claim 8 additionally requires an external power supply connected to the external USB host, and has been rejected on the additional ground that

“Since USB scanners often got their power from (sic) a host computer via the USB plug, it must replace the power. This would be obvious to one having ordinary skill.”

However, the Office Action cites no prior art that teaches a scanner that was powered from a host computer via a USB plug, and thus fails to establish *prima facie* obviousness for this reason alone. In addition, none of the references provide any teaching of (i) an external USB host that

has (ii) a first port adapted to communicate with a scanner port, (ii) a controller adapted to communicate with the scanner and (iii) and second port adapted to communicate with a USB peripheral device, all of which are affirmatively recited in pending parent claim 7 and pending dependent claim 8.


For all of the above reason the Office Action fails to establish prima facie obviousness of the claimed invention.

II. CONCLUSION

For all of the above reasons, it is believed that the above-identified patent application is now in condition for allowance.

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